

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed November 28, 2008, and the Advisory Action mailed March 23, 2009. Claims 17–37 are pending in this Application and Claims 17–37 stand rejected under 35 U.S.C. § 103(a). Claims 17, 33, and 34 have been amended to further define various features of Applicant's invention. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 17–19 and 24–36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,978,316 issued to Aamir Ghaffar et al. ("*Ghaffar*") in view of U.S. Patent Application Publication No. 2002/0032771 by Trond Gledje ("*Gledje*").

Claims 20–23 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ghaffar* and *Gledje* and further in view of U.S. Patent Application Publication No. 2004/0204073 by John Anthony Yanosy ("*Yanosy*").

In order to establish a *prima facie* case of obviousness, the cited references must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on *ex post* reasoning. *KSR*, 127 S. Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1741).

Applicant respectfully submits that the cited art combinations, even if proper, which Applicant does not concede, do not render the claimed embodiment of the invention obvious.

The cited references fail to teach or suggest all the elements of the pending claims. For example, amended independent Claim 17 recites, in part:

providing a resulting profile information object which specifies process capabilities of said terminal and said connection component;
the terminal providing a first item of profile information that specifies which type of the user data objects may be directly processed by the terminal;
inserting, in the resulting profile information, the first item of profile information

Applicant submits that *Ghaffar* fails to teach or suggest the above recited elements. As the Examiner recognized in the Final Office Action, *Ghaffar* does not disclose “providing a resulting profile information object which specifies process capabilities of said terminal and said connection component” as recited in amended Claim 17 because “*Ghaffar* does not specifically disclose profile information [that] specifies the connection component.” Final Office Action, Page 3. Likewise, because *Ghaffar* does not disclose the recited “resulting profile information,” it also cannot disclose “inserting, in the resulting profile information, the first item of profile information” recited in amended Claim 17.

Applicant respectfully submits that *Gledje* similarly fails to disclose “inserting, in the resulting profile information, the first item of profile information.” In the Advisory Action mailed on March 23, 2009, the Examiner states that *Gledje* “discloses a database that explicitly shows resulting profile information (Figs. 2A, 2B) and a first item of profile information [that] has [been] inserted into the resulting profile information.” Advisory Action, Page 2. However, Applicant has amended independent Claim 17 to clarify that “the terminal provid[es] a first item of profile information.”

Gledje is clear that the information that is inserted into the advertiser database (i.e., Fig. 2A) is not provided by the terminal as recited in amended Claim 17. To be sure, *Gledje* discloses that the information in the advertiser database (Fig. 2A) is provided and tagged “by the advertiser.” *Gledje* at [0023]. In fact, *Gledje* is silent as to the specifics of how the advertiser provides the advertising information to the advertising database. Nevertheless, it is clear that the advertiser cannot provide this information via the mobile station 110, because

the mobile station is the target of the advertisements and belongs to the subscriber, not the advertisers.

Similarly, *Gledje* is clear that the information that is inserted into the subscriber database (i.e., Fig. 2B) is not provided by the terminal as recited in amended Claim 17. *Gledje* discloses that “[t]he subscribers can inform, update and enable the advertisement service through a web-interface or through a voice communication via a dial up interface” *Gledje* at [0026]. Thus, in the case that the subscriber is inserting information into the subscriber database, such information is not provided by the terminal. *Gledje* also discloses that the “type of connection field . . . can be dynamic where the mobile network updates the database as to the bandwidth currently available to the mobile station.” *Gledje* at [0025]. In this case, it is the mobile network—not the mobile station—that is providing the information that is inserted into the subscriber database. Other than the two methods just discussed, Applicant submits that *Gledje* does not disclose any other means for providing information to the subscriber database.

In summary, *Gledje* discloses that the information inserted into the databases is provided: (1) by the advertiser (through undisclosed means), *Gledje* at [0023]; (2) by the subscriber through a web-interface or voice communication, *Gledje* at [0026]; or (3) by the mobile network. *Gledje* at [0025]. None of the information in *Gledje* is provided by the terminal. Thus, Applicant respectfully submits that *Gledje*, like *Ghaffar*, does not disclose “inserting, in the resulting profile information, the first item of profile information” because none of the information that is inserted into the *Gledje* databases is provided by the terminal, as required by amended independent Claim 17 (“the terminal providing a first item of profile information”).

Likewise, the Examiner did not argue that *Yanosy* discloses the above limitations, and Applicant submits that *Yanosy*, like *Ghaffar* and *Gledje*, fails to disclose “inserting, in the resulting profile information [which specifies the process capabilities of the terminal and the connection component], the first item of profile information [provided by the terminal].” For at least the foregoing reasons, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness.

Amended independent Claims 33 and 34 include similar limitations. For example, amended Claim 33 recites:

wherein a resulting profile information object specifies process capabilities of said terminal and said connection component;

wherein the terminal provides a first item of profile information that is subsequently inserted in the resulting profile information, the first item of profile information specifying which type of user data objects may be processed directly by the terminal;

Amended Claim 34 recites:

providing a resulting profile information object which specifies which type of the user data objects may be transmitted to the terminal, wherein the specified types in the resulting profile are either directly processed by the terminal or pre-processed by the connection component;

the terminal providing a first item of profile information that specifies which type of the user data objects may be directly processed by the terminal;

inserting, in the resulting profile information, the first item of profile information;

For reasons analogous to those discussed above regarding Claim 17, *Ghaffar*, *Gledje* and *Yanosy* fail to teach or suggest all the elements of amended Independent Claims 33 and 34. Applicant respectfully submits that the dependent claims are allowable at least to the extent of the independent claim to which they refer. Thus, Applicant respectfully requests reconsideration and allowance the independent Claims 17, 33, and 34, and all claims that depend therefrom. Applicant reserves the right to make further arguments regarding the Examiner's rejection under 35 U.S.C. § 103(a), if necessary, and does not concede that the Examiner's proposed combinations are proper.

Association of Customer Number and Change of Correspondence Address

Applicant respectfully requests that all papers pertaining to the above-captioned patent application be associated with Customer No. **86528**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **86528**. All telephone calls should be directed to Eric Grabski at 512-457-2030.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant encloses a Request for Continued Examination (RCE) and authorizes the Commissioner to charge \$810.00 (RCE fee) and \$490 (Two Months Extension of Time fee) to Deposit Account No. 50-4871 of King & Spalding LLP. Applicant believes no additional fees are due. However, should the Commissioner deem that any additional fees are due, including any fees for additional extensions of time, the Commissioner is hereby authorized to debit such fees from Deposit Account No. 50-4871.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512-457-2030.

Respectfully submitted,
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